

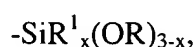
**Remarks**

Claims 1-16 stand rejected. Claim 1 has been amended, and support for this amendment may be found at paragraphs [0016], [0019], and [0037]. New claims 17 - 21 have been added. New claim 17 finds support at paragraphs [0016] and [0019] of the specification. New claim 18 finds support at paragraphs [0016] and [0037] of the specification. Support for new claims 19 - 21 may be found at paragraph [0025] and the examples.

The examiner rejected claims 1-16 under 35 U.S.C. §102(b) over U.S. Patent 6,132,664 (Freiberg) arguing that Freiberg discloses a moisture curable composition comprising an organopolysiloxane having not less than two silicon-bonded alkoxy/hydrolyzable groups and an alkoxysilane having the formula  $R^4_zSi(OR)_{4-z}$  where z can be 0, 1, or 2 and that when z is equal to 2, the organosilane has the formula  $G_2-Si-R^1_2$ . The examiner further argues that Freiberg discloses that the composition further comprises a filler and a photocatalyst. The examiner further argues Freiberg discloses that when the alkoxysilane does not contain an unsaturated group, then component (e) is provided which can be a short chain siloxane.

Freiberg discloses a composition comprising:

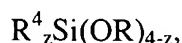
(A) polymers comprising on average at least 1.2 alkoxysilyl chain terminations per molecule described by the formula



where each R is independently selected from the group consisting of methyl, ethyl, n-propyl, isopropyl, n-butyl, sec-butyl, and isobutyl,  $R^1$  is selected from the group consisting of methyl and ethyl, and x is 0 or 1,

(B) a titanate compound comprising on average at least three alkoxy radicals bonded to titanium . . . ,

(C) an alkoxysilane described by formula



where each  $R^4$  is independently selected from monovalent hydrocarbon radicals comprising from 1 to about 12 carbon atoms, each R is as defined above, and z is 0, 1, or 2, and

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(D) a filler (col. 2, line 42-col. 3, line 16).

In the examples, Freiberg does not use any polymers or alkoxysilanes or any other species that contain vinyl or any other unsaturated group in the compositions. Freiberg teaches away from using titanate compounds having fewer than an average of three alkoxy radicals bonded to titanium (col. 2, line 42-col. 3, line 16). Freiberg does not disclose curing the compositions in the presence of light. Freiberg does not disclose any method for surface modification of cured products of the compositions. Freiberg does not teach or suggest any composition or method for preparing an elastomeric product having a surface with a maximum gloss value of 45.

A genus does not always anticipate a claim to a species within the genus (MPEP §2131.02). For example, *In re Meyer*, 599 F.2d 1026, 202 USPQ 175 (CCPA 1979) provided that '[a] reference disclosing "alkaline chlorine or bromine solution" embraces a large number of species and cannot be said to anticipate claims to "alkali metal hypochlorite."' *Akzo N.V. v. International Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) provided that '[c]laims to a process for making aramid fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98% concentrated sulfuric acid solution.'

The composition of this invention consists essentially of a) An organopolysiloxane having not less than two silicon-bonded hydroxyl or hydrolysable groups; b) A silane substantially having the formula  $G_2 - Si - R^1_2$ , wherein each group G is the same or different and is selected from the group consisting of alkoxy, acetoxy, oxime, and hydroxy groups, and each  $R^1$  independently represents an alkyl group having from 1 to 10 carbon atoms, an alkenyl group, an alkynyl group an aryl group such as phenyl, or a fluorinated alkyl group; c) one or more fillers and d) a photocatalyst; wherein, when no  $R^1$  group is either an alkenyl or alkynyl group there is provided: e) an unsaturated compound selected from the group of an unsaturated short chain siloxane, an unsaturated cyclic siloxane, an unsaturated fatty acid, an unsaturated fatty alcohol and an

unsaturated fatty acid ester; wherein the elastomeric body has a surface with a maximum gloss value of 45.

No silane cross-linkers having the formula  $G_3 - Si - R^1$  or  $G_4 - Si$ , where G and  $R^1$  are present in the composition and method of the present invention (paragraph [0020]). In contrast, Freiberg discloses a plurality of alkoxysilanes as being useful (at col. 6, lines 47-57), and these include methyltrimethoxysilane, methyltriethoxysilane, phenyltrimethoxysilane, dodecyltrimethoxysilane, ethyltrimethoxysilane, ethyltriethoxysilane, and tetraethoxysilane (and partial hydrolyzates), all of which represent numerous species outside the scope of the present invention. Freiberg discloses many species for use as the cross-linker that fall outside the scope of the claims of this invention.

Freiberg does not teach or suggest unsaturated groups are required, or provide any benefit, in the compositions of Freiberg. Freiberg suggests that unsaturated groups are NOT required because none of the examples of Freiberg employ any components with any unsaturated groups. In contrast, example 1 of this invention shows the unexpected benefit of improved gloss and surface modification by the incorporation of an unsaturated (*e.g.*, vinyl containing) component (paragraph [0056]). By using a vinyl containing dialkoxysilane cross linker component in example 1A, gloss improves to a value of 22.62 as compared to example 1B in which no unsaturated component is used and gloss is 82.74 (paragraph [0057] and table). Furthermore, by using a vinyl containing dialkoxysilane cross linker component in example 1A, gloss improves to a value of 22.62 as compared to example 4A, in which a trialkoxysilane crosslinker is used instead, and gloss is 59.72 (paragraph [0062] and table). The crosslinkers of comparative examples 1B and 4A both fall within the scope of Freiberg and outside the scope of this invention.

In the office action dated 22 February 2008, the examiner seems to argue that the instant application contains inadequate disclosure as to how to obtain the claimed properties with the

claimed ingredients. The applicants respectfully disagree. Multiple examples and comparative examples are provided at paragraphs [0047] – [0072] showing how to select ingredients, combine them, and cure them to provide a cured product having an air-sealant interface surface with a maximum gloss value of 45.

For example, example 1A of this invention and comparative example 1B show the benefit of using an unsaturated group containing cross linker over a composition in which no unsaturated component is used. Example 1A has gloss of 22.62, but comparative example 1B has gloss of 82.74 (p. 20), thereby showing that Example 1A of the invention has a matte finish and comparative example 1B does not. Comparative example 1B contains a dialkyldialkoxysilane crosslinker (dimethyldimethoxysilane) and no unsaturated compound, which is inside the description of Freiberg. Freiberg provides, “Examples of useful alkoxysilanes include. . . dimethyldimethoxysilane” (col. 6, lines 47-54 at line 52). Freiberg does not teach or suggest adding an unsaturated compound when none of the other components contain an unsaturated group.

Example 2 of this invention shows the benefit of using the unsaturated compound e) in a composition in which the crosslinker b) (and the other components of the composition) do not contain an unsaturated group. Gloss in this example was 10.26.

Example 1A and comparative example 4A of this invention show the benefit of using an unsaturated dialkoxysilane crosslinker over an unsaturated trialkoxysilane crosslinker. Example 1A contains an unsaturated dialkoxysilane crosslinker and has a gloss of 22.62, as described above, and comparative example 4A has a gloss of 59.72. Comparative example 4A uses vinyltrimethoxysilane as the crosslinker, which is outside the scope of this invention but inside the description of Freiberg. Freiberg provides, “Examples of useful alkoxysilanes include methyltrimethoxysilane” (col. 6, lines 47-54 at line 48). Based on the disclosure of Freiberg, one skilled in the art would not know how to select a suitable crosslinker to arrive at this invention.

With respect to claim 15, examples 7A, 1A, and 7B show the benefit of curing in the presence of light. For these reasons, claims 1-18 are novel and unobvious over Freiberg, and applicants have presented evidence of this.

Furthermore, with respect to new claims 19-21 in this application, Freiberg discloses the titanate catalyst must have on average at least three alkoxy radicals bonded to titanium (col. 5, line 53 to col. 6, line 8). Freiberg explicitly teaches away from new claims 19-21 because Freiberg discloses that the titanate must have on average at least 3 alkoxy radicals bonded to titanium (col. 6, lines 1-15).

Freiberg fails to disclose the specific combination of components claimed herein, and benefits provided thereby. The instant invention is novel and unobvious. Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

This reply is being submitted within the period for response to the outstanding office action. Although the applicants believe in good faith that no extensions of time are needed, the applicants hereby petition for any necessary extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,  
Dow Corning Corporation



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